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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,450	10/29/2003	Alex Kunzler	31132.165	5975
46333 7590 01/24/2008 HAYNES AND BOONE, LLP 901 Main Street Suite 3100 Dallas, TX 75202			EXAMINER SWIGER III, JAMES L	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 01/24/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,450

Applicant(s)

KUNZLER, ALEX

Examiner

James L. Swiger

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30, 32-35 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 21, 22, 25-30, 34 and 35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-39 is/are allowed.
- 6) ☒ Claim(s) 1-20, 23, 24, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/17/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The content of the specification should be updated to reflect the current status of the applications that are cross-related. Application 10/294,502 should be updated to reflect its current status as now patent 7,294,131.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be "material to patentability as defined in 37 CFR 1.56".

Double Patenting

Claims 1, 2, 4 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 7,294,131. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim a guide body and a bone removal device with an axis, a guide member capable of movement through axes, predetermined movement, a body considered as a cage, and a track portion. It is further noted that the difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of

the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 6 rejected under 35 U.S.C. 102(b) as being anticipated by Gittleman (US Patent 4,359,318). Gittleman discloses a device capable of preparing bone having a guide body (56) a bone removal device (70/72) having a longitudinal axis (created along line 68), a pair of guide members (60) that are movable engaged with the guide body (they are connected at the body location) and moveable about a bone removal device. The guide members also form an alignment axis. With regards to the longitudinal axis and alignment axis placement, it is noted that an alignment device (58) is capable of allowing the alignment axis and longitudinal axis be substantially parallel because as the alignment device moves downward, the guide members (60) approach a parallel placement, parallel with respect to the longitudinal axes. The guide members are capable of guiding the device as a whole and also can move the guide body in a predetermined pattern.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 17-18, 20, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz et al. '714 in view of Zarnowski et al. (US Patent 4,892,093).

Dietz et al. disclose a device to cut and prepare bone having a guide body (10), a bone removal device (6) having a longitudinal axis between its own proximal and distal portion (at 6 end), a pair of guide members (32), an alignment device movably engaged between guide body and device, and where the bone removal device is capable of being moved along a predefined pattern along the guide members in use. Dietz et al. also disclose that the guide members are rotatably, or pivotally connected to the bone removal device (via the projection to pivot, 36) where the guide members may also be considered rotationally connected. These pivots are also considered projections, and although only one is shown in Fig. 5, there would have to be a second one present, since in Fig. 5 only a cut away portion of the full device is shown. With regards to the bone milling pattern, the device is capable of producing a pattern either circular in shape or toroidal (donut-shaped) by the movement along the guide members *and simultaneous movement by the cutting guide* if one wishes to do so. Further the guide members each have a major side surface (see profile in Fig. 3 of 32) and wherein the predetermined pattern may be in a plane substantially parallel to the longitudinal axis (in

the direction of the guide members), depending on how one looks at the device. The device may be considered to be housed in a "cage" (12) and has a connecting rod (42). The device also has an inner surface with a track (16) that enables the guide members to control said bone removal device. The bone prep device is also considered to have a bone removal element (the serrations of 6, see Fig. 7) that has an axis of rotation that may be considered offset with respect to the longitudinal axis. This axis may be considered substantially transverse depending on how it is oriented, therefore being capable of a non-linear predetermined pattern. The alignment device is also capable of controlling the speed and direction of its guide members, depending on how it is used.

Dietz et al. disclose the claimed invention except for the guide members being substantially aligned along an alignment axis substantially parallel to the axis of the bone removal device. Zarnowski et al. disclose a device wherein a bone removal device with a longitudinal axis (50) can slide and tilt along the guide area created by (34). As the cutting device may slant and angle towards one corner of the guide area, its axis is then *substantially* aligned with that of the guide device. Thus the two axes are considered substantially parallel. See Col. 4, lines 9-39.

Alternatively, Zarnowski et al. may be defined in another way. The cutting edge of 50 in Zarnowski et al. may be considered to define its own longitudinal axis as a bone cutting device (see serrated edges). In this perspective, the proximal and distal ends are defined on either side of the bladed portion to create a longitudinal axis, as required by

the claim. Having a longitudinal axis, this axis would not "extend over" an alignment axis formed by the guide members, and the two axes would be substantially parallel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Dietz et al. having at least its guide members being substantially aligned along an alignment axis substantially parallel to the axis of the bone removal device in view of Zarnowski et al. to better align the device and cut the bone area

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Dietz et al. (US Patent 5,653,714) and Zarnowski et al. '093 as applied to claim 1 above, and further in view of Michelson (US Patent 6,537,279). The combination of Dietz et al. and Zarnowski et al. disclose the claimed invention except for the bone removal device being coupled to a power source. Michelson discloses a preparation device that is connected to a power source to help drive the device in use. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of Dietz et al. and Zarnowski et al. having at least a power source (Col. 5, lines 1-14) to better use the device.

Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Dietz et al. '714 and Zarnowski et al. '093 as applied to claim 1 above, and further in view of Morrison (US Patent 3,978,862). The combination of Dietz et al. and Zarnowski et al. disclose the claimed invention except for a gear. Morrison discloses a cutting device that has a gear (37) to aid in driving the cutter portion of the bone alignment device (Col. 3, lines 40-45). It would have been obvious to one having

ordinary skill in the art at the time the invention was made to construct the device of Dietz et al. and Zarnowski et al. having at least a gear in view of Morrison to better operate the device to move the cutter in use.

Response to Arguments

With regards to applicant's arguments regarding the Dietz et al. reference, the rejection has been clarified. The claim essentially requires a body and bone removal device in relation to one another, with guide members in between that can meet certain axial and movement-related requirements. Dietz et al. teaches the structure as positively claimed, however lacks certain movement and axial requirements, and are rejected in view of Zarnowski et al. Also, the Dietz et al. rejection has been clarified due to omitted arguments and structural elements.

Allowable Subject Matter

Claims 37-39 are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

Application/Control Number:
10/696,450
Art Unit: 3733

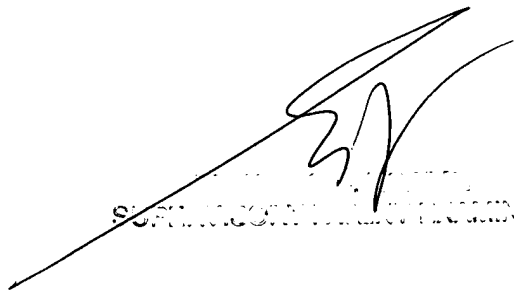
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 1/18/08

JLS


SUPERVISOR